



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office,
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,486	08/28/2000	Hidehisa Shitomi	ASA-926	5771

24956 7590 01/12/2004

MATTINGLY, STANGER & MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,486

Applicant(s)

SHITOMI ET AL

Examiner

Sabrina Chang

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's addition of claims 14 and 15 have been considered

Response to Arguments

Applicant's arguments filed 10/31/03 have been fully considered but they are not persuasive.

If applicant does not seasonably traverse the well-known statement, or official notice, during examination, then the object of the well-known statement is admitted as prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made.

To adequately traverse an official notice, an applicant must specifically point out the supposed errors in the examiner's action, stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice is inadequate. [MPEP 2144.03(c)].

As in this case, where the applicant has not traversed the examiner's assertion of official notice, the statement is taken to be admitted prior art.

In the Office's rejection dated 7/6/03 (Paper 11) the Examiner used official notice to demonstrate that a user could search for an application based upon any number of means, such as

Art Unit: 3625

functionality criteria. Applicant asserts in his arguments that the examiner's rejection does not overcome the limitation of "charging requirements". Examiner respectfully disagrees.

It is commonly known in the art of electronic commerce that a consumer can use any number of attributes to search for a desired product – for example: manufacturer, color, functional capability, price, etc. The official notice regarding e-commerce (Paper 11) generally addresses a consumer's ability to search for a product based upon any desired attribute. "Charge requirements" are merely a subset of functionality requirements.

Restatement of the rejection is provided below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the services described in the article "One-Stop ASP Service for Small and Midsize Businesses Could be the End of Packaged Small Business Software" (April 17, 2000. New York) in view of official notice regarding e-commerce.

"One-stop" discloses a service, StageBuilder™ that allows businesses to select, over the Internet, from an extensive menu ("tags" stored in relation to a number of services) of enterprise software applications. The concept of renting applications over a network, also known as Application Service Providers (ASP) is widely known in the art [see articles labeled 2-7]. StageBuilder™ allows business administrators to turn on/off any particular application service

Art Unit: 3625

(selecting another service when functional requirements are not met). Administrators have a single sign-on to access all ASPs (user name/login) and are given consolidated billing for all services. Users are charged at a wholesale rate based upon usage (counter).

StageBuilder™ offers a number of additional services including automated data exchange, ASP interoperability, caching and optimized service delivery (performing data format conversion between input by user and server-side applications).

“One-stop” does not explicitly disclose that the user can input function or charge requirements in searching for a particular software application.

Official notice is taken that the ability to enter functionality criteria or demands in order to search for a particular item is well known in the art of electronic commerce. Such a capability is necessary to aid the end-user in finding the most appropriate product. In that StageBuilder™ offers a variety of services, it would have been obvious to allow the end-user to search these offerings by inputting his/her functional criteria or charge requirements, as taught by official notice, in order to make increase likelihood of a expedient purchase.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The articles, "Soft wired" [2] "Online software catches on Firms connect with application services to save time" [3] "Providers put faith in Internet" [4] "Web-based software providers seek focus" [5] "ASP a low-cost, low-risk alternative to a client-server application" [6] and “ASP's are coming ASAP” [7] discuss the proliferation of ASPs generally. The articles do not

Art Unit: 3625

explicitly disclose the delivery of ASPs from a central location or an end user's ability to select from a plurality of services.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 7687 for regular communications and 703 305 7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

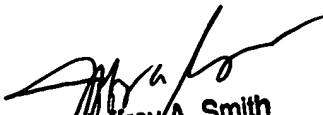
Application/Control Number: 09/648,486

Page 6

Art Unit: 3625

SC

January 11, 2004


Jeffrey A. Smith
Primary Examiner